

Application No. 10/525,374
Reply to Office Action of October 1, 2008

REMARKS

After entry of the present amendment, claims 1, 2, and 6-9 are pending in the application. Claims 10-13 stand withdrawn. Claims 1, 2, and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,639,582 ("Imai"). Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Imai as applied to claim 1, and further in view of U.S. Patent No. 4,973,541 ("Kohri"). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Imai as applied to claim 7, and further in view of U.S. Patent Application Publication No. US 2002/0055050 A1 ("Serizawa"). Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Imai in view of U.S. 6,171,743 ("Nakamura").

Claim 1 is amended to correct a typographical error from the previous amendment, and to bring the claim back into accord with the rest of the specification (*See, e.g.*, ¶¶ 36, 64).

Applicant respectfully requests reconsideration and allowance in light of the foregoing amendments and the following remarks herein.

Claims 1, 2, and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Imai. The Office Action suggests that Imai discloses a ground toner comprised of a core substance surrounded by a thin shell and refers to the disclosure of Example 5 at Column 10 and lines 30-43 (Office Action, p. 3). Applicants disagree. Imai only describes a polymerized toner with a thin shell coating (Col. 10, lines 38-47). Imai does not describe a ground toner with its thin shell coating.

While Imai mentions grinding in Example 5 (Col. 17, lines 30-43), it does not describe any shell formed around the core in this Example. Therefore, Imai only describes a polymerized toner with a urea-formaldehyde resin coating, and when Imai describes grinding, it does not provide for any coating. This is a significant distinction. As described in a previous response, the surfaces of ground and polymerized toners are completely different (i.e.,

Application No. 10/525,374
Reply to Office Action of October 1, 2008

hydrophobic versus hydrophilic). Thus, from a practical point of view, it is completely impossible to know or predict based on a reference describing a polymerized (hydrophilic) toner whether it is also possible to coat a ground (hydrophobic) toner.

Dependent Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Imai in view of Kohri. Claim 6 depends from Claim 1 and is allowable for all the reasons discussed above. The secondary reference Kohri applied here does not overcome the deficiencies of Imai.

Kohri relates to liquid core capsule toners (Col. 3, lines 7-14), as opposed to solid ground toners. As mentioned above, Imai relates to polymerized toners. Dependent Claim 6, on the other hand, relates to a ground toner with a thin-film thickness of 0.005-1 μm . Again, it is impossible to predict with any reasonable certainty whether it is feasible to coat a *ground* toner from references describing *polymerized* toners and *liquid* cores.

Dependent Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Imai in view of Serizawa. The Office Action concedes that Imai does not disclose aggregation. The Office Action then states that Serizawa describes aggregation and suggests that it would have been obvious to use Serizawa's aggregation in combination with Imai's film-coated toner particles. Applicants disagree.

Serizawa discloses a toner and process for producing a toner wherein a resin particle dispersion, a particle stabilizer dispersion, a pigment dispersion and a releasing agent are mixed to form aggregated particles which are subsequently heated and fused to form toner particles (§§ 93-94). Serizawa does not disclose coating the aggregated particles. That is, Serizawa does not disclose or suggest first aggregating primary toner particles into secondary toner particles and, then, subsequently coating the aggregation of secondary particles with a thin film of thermosetting resin without fusing the powder toner (see, e.g., §§ 231-38). The proposed combination of Imai and Serizawa does not suggest coating aggregated particles because there is no evidence provided in either Imai or Serizawa that suggests applying a coating over aggregated particles.

Application No. 10/525,374
Reply to Office Action of October 1, 2008

Dependent claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Imai in view of Nakamura. However, Nakamura does not overcome the deficiencies of Imai. Nakamura, like Imai, discloses only polymerized toner (Col. 6, lines 17-36).

Conclusion

Applicant respectfully requests entry of the present amendment, reconsideration and withdrawal of the rejections to claims 1, 2, and 6-9, and allowance of this application. The Commissioner is hereby authorized to charge any additional fees which may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 06-1135, regarding our order number 7398/84282.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY



Kendrew H. Colton
Registration No. 30,368

Dated: December 23, 2008

Customer No. 42798

One Lafayette Centre
1120 20th St. NW - Suite 750 South
Washington, D. C. 20036

tel: 202-419-7000
fax: 202-419-7007